

REMARKS/ARGUMENTS

The Office is requiring restriction to one of the following groups:

- Group I: Claims 1-5, 7, and 12-14, drawn to a lithium secondary battery negative electrode having a thin film of silicon oxide formed by vacuum vapor deposition or sputtering on the surface of a collector;
- Group II: Claims 6 and 18, drawn to a lithium secondary battery negative electrode, being SiO film type negative electrode having a capacity sustainability;
- Group III: Claims 8-11, drawn to a film forming material; and
- Group IV: Claims 15-17, drawn to a fabricating method for a lithium secondary battery negative electrode with a cleaning treatment.

Applicants elect with traverse Group I, Claims 1-5, 7 & 12-14, for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office alleges that Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: “The common special technical feature present in all the groups is a negative electrode for a lithium secondary battery having a thin film of silicon oxide. This cannot be a special identical feature under PCT Rule 13.2 because the feature is shown in the prior art. Hiroyuki et al. (JP 2002-042809, machine translation) discloses

an electrode active material capable of storing and releasing ions comprised of SiO_x [Abstract]. Yoichi et al. (JP 2001-210319, machine translation) teaches a method of forming an electrode for lithium secondary batteries by forming a thin film on the surface of a collector [0007, 0008]. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the electrode of Hiroyuki using the method of forming a thin film because Yoichi teaches the formation of a thin film allows for sufficient adhesion on the charge collector, therefore presenting a lack of unity between the groups *a posteriori*.”

Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states, emphasis added:

The expression “special technical feature” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, ***considered as a whole***, makes over the prior art. The determination is made on the contents of the claims as ***interpreted in light of the description*** and drawings (if any).

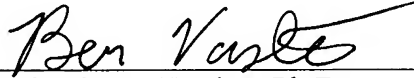
Applicants respectfully submit that the Office did not consider the contribution of each invention, ***as a whole***, in alleging the lack of a special technical feature. Applicants also respectfully submit that the Office has not provided any indication that the contents of the claims ***interpreted in light of the description*** were considered in making this allegation. Therefore, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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